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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,881	01/29/2004	Javier Patron	PATRO.001A	7301

20995 7590 11/25/2005

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EXAMINER
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PRINCE, FRED G

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/768,881

Applicant(s)

PATRON, JAVIER

Examiner

Fred Prince

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 12-14 and 17-21 is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102/103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6-9, are rejected under 35 U.S.C. 102(b) as being by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pare et al. (US Pat No 5,389,248).

Pare et al., directed toward a filter system and method, teach a filter system including a biological chamber (20) for holding biological media (68), at least two drip drawers (60, 62, 64) on a ledges (65), the drawer having a plurality of bores (66) providing even distribution (col. 7, lines 44-50 and 59-63). It is submitted that the drawers are inherently rotatable by 180° as the drawers are uniformly shaped (Fig. 1) and merely rest on the ledges for support.

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Regarding the preamble recitation that the filter system is “for use in an aquarium”, it is submitted that the recitation is one of intended use that fails to further limit or add structure to the claimed apparatus. If it is applicant’s position that the limitation somehow adds structure to the claimed apparatus, it is submitted that the filter of Pare et al is structurally capable of treating aquarium water.

4. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare et al. in view of Bender et al. (US Pat No 6,008,028).

Pare et al. is described above. Pare et al. do not disclose providing a media filter pad including charcoal.

In any case, Bender et al., also directed toward a filter system, disclose the well known concept of providing a bioreactor with a filter media pad (col. 8, lines 49-58) including charcoal (col. 4, line 13) in order to, for example, form a complex ecosystem to biodegrade various contaminants (abstract; col. 4, lines 17-34; col. 14, lines 31-57).

It would have been readily obvious for the skilled artisan to modify the filter system of Pare et al. such that it includes a filter media pad including charcoal in order to, for example, form a complex ecosystem to biodegrade various contaminants, as suggested by Bender et al.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 6-11 have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amendment.

***Allowable Subject Matter***

6. Claims 1-5, 12-14, and 17-21 are allowed.

Per claims 1-5 and 12-14, the claims are allowed for the reasons presented by applicant in the Remarks received by the Office on October 5, 2005.

Per claims 17-21, while it is known in the art to provide a method of filtering water including collecting water, directing said water to at least one removable drip drawer in a biological chamber, wherein the drip drawer comprises a plurality of bores for distributing water evenly over biological media, wherein said at least one removable drip drawer is inherently rotatable so as to be removed from said biological chamber in a first direction and a second direction; and distributing said water substantially evenly over said biological media in the biological chamber (see, for example, US Pat No 5,389,248), in the examiner's opinion, the prior art fails to teach or fairly suggest the water being collected from an aquarium. It is the examiner's opinion that the skilled artisan would not have looked to the filtering method of Pare et al. to filter aquarium water since an aquarium would not be expected to contain the contaminants found in the water filtered in method of Pare et al.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References are cited of interest to show the state of the art.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Prince whose telephone number is (571) 272-1165. The examiner can normally be reached on Monday-Thursday, 6:30-4:00; alt. Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Fred Prince  
Primary Examiner  
Art Unit 1724

fgp  
11/21/05